



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,475	04/23/2001	Michael J. Sullivan	P-4628-D1-1-C1-1	5756

24492 7590 08/19/2002

MICHELLE BUGBEE, ASSOCIATE PATENT COUNSEL
SPALDING SPORTS WORLDWIDE INC
425 MEADOW STREET
PO BOX 901
CHICOPEE, MA 01021-0901

EXAMINER

BUTTNER, DAVID J

ART UNIT	PAPER NUMBER
----------	--------------

1712

DATE MAILED: 08/19/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/840,475

Applicant(s)

SULLIVAN ET AL.

Examiner

David Buttner

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

Art Unit: 1712

DETAILED ACTION

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

This application was not filed within 12 months of the filing date of 60/042439. This claim of priority must be removed.

08/870,585 (based on review of US 6210293) does not provide basis for the current claims. The alleged parent lacks reaction injection molding, the species of fillers, specific gravity range, dual cores and location of filler in such a dual core. None of applicant's claims can rely on this application's filing date.

09/049,410 (based on review of US 6057403) does not provide basis for reaction injection molding, the species of fillers, specific gravity range or soft inner cover-hard outer cover. Claims 1, 3, 4, 6-15, 17, 18 and 26 have basis in 09/049,410 and therefore receive its filing date of March 27, 1998.

08/⁶³¹~~613~~,613 (from review of US 5803831) lacks reaction injection molding, the species of fillers, specific gravity range, soft inner cover-hard outer cover, thermoplastic center cores, a fifth layer between the dual core and dual cover or a clear teaching of locating density adjusting filler in the center core of a four layer ball. None of applicant's claims receive the benefit of 08/631,613's filing date.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1712

Claim 28 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim does not indicate where or when the isocyanate is added.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 1-3, 5, 7, 9, 12-14, 16, 19-23 and 25 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Moriyama '396 patent.

Moriyama exemplifies (table 5, 6) four layer golf balls having tungsten in the center core and a polyurethane outer cover. The polyurethane outer cover has a shore D of 71-72. The layer immediately inside the outer cover has a shore C of 54-57. These shore C values convert to a

Art Unit: 1712

lower numerical value on the shore D scale (see applicant's own correlation col 5 line 54 of US 6057403).

Claims 1-3, 6-15, 17-22, 26 and 28 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Hayashi '460 patent.

Hayashi exemplifies (#1-3) four layer golf balls having barium sulfate in the center core, with a urethane outer cover. The outer cover is significantly softer than the inner cover.

Claims 1-3, 6-15, 17-22, 26 and 28 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Herbert '172 patent.

Herbert discloses a four layer golf ball having a urethane outer cover. This outer cover is significantly ^{softer} harder than the inner cover (claims 3 and 5). Density adjusting can be present in the core (col. 7, line 18).

Claims 19-25 rejected under 35 U.S.C. 103(a) as being unpatentable over the Moriyama '396 or Hayashi '460 or Herbert '172 patents in view of Rajagopalan '049 or Sullivan '553.

The three primary references suggest high density fillers in the their cores, but do not suggest all the species named by applicant.

Rajagopalan (col. 7, line 25) and Sullivan (col. 3 line 21) suggest titanium, tungsten etc all function as density adjusting fillers in golf ball cores. It would have been obvious to use any of the listed fillers in the cores of Moriyama/Hayashi/Herbert to adjust their density.

Claims 26-28 rejected under 35 U.S.C. 103(a) as being unpatentable over the Hayashi '460 patent in view of Sullivan '119.

Art Unit: 1712

Hayashi does not explain what molding technique was used to place the urethane cover on the ball. Compression molding, reaction injection molding etc (co. 23 line 12 of Sullivan) are all well known molding techniques for forming golf ball covers. Reaction injection molding is particularly useful for urethanes (clam 14 of Sullivan).

It would have been obvious to use any common molding technique to place the urethane cover on Hayashi 's ball.

Claims 1-15, 18-23, 25, 26 and 28 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Melvin '562 patent .

Melvin discloses four layer golf balls. The cover can be polyurethane (col. 18 line 37-53). The inner core can be thermoplastic (col. 5, line 32) and contain tungsten filler (col. 7, line 55).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 703-308-2403. The examiner can normally be reached on weekdays from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 703-308-2340. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Application/Control Number: 09840475

Page 6

Art Unit: 1712

DButtner:evh

DAVID J. BUTTNER
PRIMARY EXAMINER

8/15/02

David Buttner